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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/656,194	09/08/2003	Hisayasu Nakao	1046.1299	8380
21171 7590 08/20/2008 STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005				
EXAMINER				
HAMZA, FARUK				
ART UNIT		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/656,194

Applicant(s)

NAKAO, HISAYASU

Examiner

FARUK HAMZA

Art Unit

2155

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22, 27-48, 53-74 and 79-100 is/are pending in the application.
- 4a) Of the above claim(s) 23-26, 49-52, 75-78 and 101-104 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22, 27-48, 53-74 and 79-100 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 September 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-846)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 09/08/03, 12/16/03
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is responsive to the communication filed on August 14, 2008. Applicant's election without traverse of species I (claims 1-22, 27-48, 53-74 and 79-100) in the reply filed on August 14, 2008 is acknowledged. Claims 23-26, 49-52, 75-78 and 101-104 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Species II, there being no allowable generic or linking claim. The applicant is requested to cancel the non elected claims in response to this office action. Claims 1-22, 27-48, 53-74 and 79-100 are pending.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the claimed limitation "an accept unit accepting a setting request of a forward destination address corresponding to a receipt address of the E-mail" "a confirming unit executing a confirmation of a validity of the forward destination address" "a command unit issuing a command of confirming a validity of the forward destination address" "a sending unit sending a test mail to the forward destination address" "a receiving unit receiving a response to the test mail" "confirming unit commands said sending unit to send the test mail and confirms a response via said receiving unit" "a forward destination registering unit registering the forward destination address if the confirmation proved successful; and a forward control unit forwarding the E-mail, wherein said forward control unit,

where the forward destination address corresponding to the receipt address is registered in said forward destination registering unit, forwards the received E-mail addressed to this receipt address to the forward destination address” “forward destination registering unit registers a forward destination address unconditionally in response to said setting request for setting the forward destination address that is within a predetermined range, and registers a forward destination address with respect to which the confirmation by said confirming unit proved successful in response to said setting request for setting the forward destination address that is beyond the predetermined range” “a notifying unit notifying that a permission of forwarding to the forward destination address with respect to which the confirmation proved unsuccessful, can not be given” must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional

replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 53-74 and 79-100 are rejected under 35 U.S.C. 101 because claimed invention directed to non-statutory subject matter.

Claim 53 recites "program comprising". A program is non-statutory subject matter. Claims 54-74 have the same deficiency of their base claims.

Claims 79 and 92 recite "data signal" and "carrier wave". "Data signal" and "carrier wave" are not tangible. Claims 55-91 and 93-100 have the same deficiency of their base claims.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent

granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-22, 27-48, 53-74 and 79-100 are rejected under 35

U.S.C. 102(e) as being anticipated by IwaZaki (U.S. Patent Number 6,457,044)

hereinafter referred as IwaZaki.

IwaZaki teaches the invention as claimed including an electronic-mail address and communication condition information associated with the address are stored in an address book in correspondence with each other. If a destination address is registered in the address book, before image transmission, a CPU receives communication condition information corresponding to the destination address through an address book management section and determines the transmission mode on the basis of the communication condition information (abstract).

As to claim 1, IwaZaki teaches 1. An E-mail management system for managing a forward destination of an E-mail, comprising:

an accept unit accepting a setting request of a forward destination address corresponding to a receipt address of the E-mail (Column 5, lines 41-61, IwaZaki discloses setting destination address corresponding receipt address); and

a confirming unit executing a confirmation of a validity of the forward destination address (Column 5, lines 62-Column 6, lines 20, IwaZaki discloses confirming validity of destination address).

As to claim 2, IwaZaki teaches an E-mail management system according to claim 1, further comprising:

a sending unit sending a test mail to the forward destination address (Column 5, lines 62-Column 6, lines 20, Column 6, lines 62-Column 7, lines 15);
and

a receiving unit receiving a response to the test mail, wherein said confirming unit commands said sending unit to send the test mail and confirms a response via said receiving unit (Column 5, lines 62-Column 6, lines 20).

As to claim 3, IwaZaki teaches an E-mail management system according to claim 1, further comprising a communication unit communicating with a sending device sending a test mail to the forward destination and a receiving device receiving a response to the test mail, wherein said confirming unit commands said sending device to send the test mail via said communication unit and confirms the response received by said receiving device via said communication unit (Column 5, lines 62-Column 6, lines 20, Column 6, lines 62-Column 7, lines 15).

As to claim 4, IwaZaki teaches an E-mail management system according to claim 1, further comprising: a forward destination registering unit registering the forward destination address if the confirmation proved successful; and a forward control unit forwarding the E-mail, wherein said forward control unit, where the forward destination address corresponding to the receipt address is registered in said forward destination registering unit, forwards the received E-

mail addressed to this receipt address to the forward destination address (abstract, Column 5, lines 62-Column 6, lines 20, Column 6, lines 62-Column 7, lines 15).

As to claim 5, IwaZaki teaches an E-mail management system according to claim 1, further comprising a communication unit communicating with a mail server which registers the forward destination address corresponding to the receipt address of the E-mail, and forwards the received E-mail addressed to this receipt address to the forward destination address, wherein said confirming unit commands if the confirmation proved successful, said mail server to register the forward destination address corresponding to the receipt address via said communication unit (Column 5, lines 62-Column 6, lines 20, Column 6, lines 62-Column 7, lines 15).

As to claim 6, IwaZaki teaches an E-mail management system according to claim 2, wherein said confirming unit confirms whether or not the response is transmitted from the receipt address (Column 5, lines 62-Column 6, lines 20, Column 6, lines 62-Column 7, lines 15).

As to claim 7, IwaZaki teaches an E-mail management system according to claim 1, wherein said confirming unit issues a command of sending test mails respectively to the receipt address and the forward destination address, and confirms responses to these two test mails (Column 5, lines 62-Column 6, lines 20, Column 6, lines 62-Column 7, lines 15).

As to claim 8, IwaZaki teaches an E-mail management system according to claim 4, wherein said forward destination registering unit registers a forward destination address unconditionally in response to said setting request for setting the forward destination address that is within a predetermined range, and registers a forward destination address with respect to which the confirmation by said confirming unit proved successful in response to said setting request for setting the forward destination address that is beyond the predetermined range (Column 5, lines 39-Column 6, lines 7).

As to claim 9, IwaZaki teaches an E-mail management system according to claim 1, further comprising a notifying unit notifying that a permission of forwarding to the forward destination address with respect to which the confirmation proved unsuccessful, can not be given (Column 7, lines 61-63).

As to claim 10, IwaZaki teaches an E-mail management system according to claim 4, wherein said confirming unit confirms a validity of the already-registered forward destination address after a predetermined period of time has elapsed since the registration thereof, and said forward control unit suspends forwarding to the forward destination address till the confirmation proves successful after the elapse of the predetermined period of time (Column 5, lines 62-Column 6, lines 20, Column 6, lines 62-Column 7, lines 15).

As to claim 11, IwaZaki teaches an E-mail management system according to claim 5, wherein said communication unit receives a request for confirming the already-registered forward destination address from said mail server, and said

confirming unit confirms the validity of this forward destination address (Column 6, lines 62-Column 7, lines 15).

As to claim 12, IwaZaki teaches an E-mail management system according to claim 1, further comprising an information providing unit disclosing a step of the response to a test mail, to a user who is within a predetermined range, wherein said confirming unit confirms whether or not the response conforms with the response step (Column 5, lines 62-Column 6, lines 20, Column 6, lines 62-Column 7, lines 15).

As to claim 13, IwaZaki teaches an E-mail management system according to claim 1, wherein said confirming unit confirms whether the response contains a predetermined data string or not (Column 6, lines 62-Column 7, lines 15).

As to claim 14, IwaZaki teaches an E-mail management system cooperating with a mail server which registers a forward destination address corresponding to a receipt address of an E-mail and forwards the received E-mail addressed to this receipt address to the forward destination address, said system comprising:

an accept unit accepting a setting request of a forward destination address corresponding to a receipt address of the E-mail (Column 5, lines 41-61); and

a command unit issuing a command of confirming a validity of the forward destination address (Column 5, lines 62-Column 6, lines 20).

As to claim 15, IwaZaki teaches an E-mail management system according to claim 14, further comprising a sending unit sending a test mail to the forward

destination, wherein said command unit commands said sending unit to send a test mail and has a validity of the forward destination address confirmed by a response to the test mail, to said mail server from the receipt address (Column 5, lines 62-Column 6, lines 20, Column 6, lines 62-Column 7, lines 15).

As to claim 16, IwaZaki teaches an E-mail management system according to claim 14, further comprising a communication unit communicating with a sending device sending a test mail to the forward destination, wherein said command unit commands said sending device to send the test mail to the forward destination address via said communication unit and has the validity of the forward destination address confirmed by a response to the test mail, to said mail server from the receipt address (Column 5, lines 62-Column 6, lines 20, Column 6, lines 62-Column 7, lines 15).

As to claim 17, IwaZaki teaches an E-mail management system according to claim 16, wherein said sending device is said mail server (Column 1, lines 65-Column 2, lines 3).

As to claim 18, IwaZaki teaches an E-mail management system according to claim 14, wherein said command unit issues a command of sending test mails respectively to the receipt address and the forward destination address, and makes said mail server confirm the validity of responses to these two test mails (Column 5, lines 62-Column 6, lines 20, Column 6, lines 62-Column 7, lines 15).

As to claim 19, IwaZaki teaches an E-mail management system according to claim 16, wherein said communication unit receives a request for confirming

the already-registered forward destination address from said mail server, and said command unit issues the command of confirming the validity of this forward destination address (Column 5, lines 62-Column 6, lines 20, Column 6, lines 62-Column 7, lines 15).

As to claim 20, IwaZaki teaches an E-mail management system according to claim 14, further comprising an information disclosure unit disclosing a step of the response to a test mail, to a user who is within a predetermined range (Column 5, lines 62-Column 6, lines 20, Column 6, lines 62-Column 7, lines 15).

As to claim 21, IwaZaki teaches an E-mail management system according to claim 1, wherein said accept unit accepts the setting request by receiving the E-mail in a predetermined format at a predetermined address (Column 5, lines 62-Column 6, lines 20).

As to claim 22, IwaZaki teaches an E-mail management system according to claim 14, wherein said accept unit accepts the setting request by receiving the E-mail in a predetermined format at a predetermined address (Column 5, lines 62-Column 6, lines 20).

Claims 27-48, 53-74 and 79-100 do not teach or define any new limitations other than above claims 1-22. Therefore, claims 27-48, 53-74 and 79-100 are rejected for similar reasons.

5. **Examiner's Note:** Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings

Art Unit: 2155

of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in its entirety as potentially teaching of all or part of the claimed invention, as well as the context.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Faruk Hamza whose telephone number is 571-272-7969. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar can be reached at 571-272-4006. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 886-217-9197 (toll –free).

Faruk Hamza

Patent Examiner

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/saleh najjar/

Supervisory Patent Examiner, Art Unit 2155